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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/768,778	01/30/2004	George Matlock	017761-003900US	7157
20350	7590	12/29/2005		
TOWNSEND AND TOWNSEND AND CREW, LLP TWO EMBARCADERO CENTER EIGHTH FLOOR SAN FRANCISCO, CA 94111-3834			EXAMINER GIBSON, ROY DEAN	
			ART UNIT 3739	PAPER NUMBER

DATE MAILED: 12/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/768,778

Applicant(s)

MATLOCK, GEORGE

Examiner

Roy D. Gibson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 19-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-16 is/are allowed.
- 6) ☒ Claim(s) 17-28 and 30-35 is/are rejected.
- 7) ☒ Claim(s) 29 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/19/2005.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

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DETAILED ACTION

Specification

The blank lines on pages 14 and 23 of the Specification should be filled with the the S/N of the referenced application(s).

Claim Rejections - 35 U.S.C. § 112

Claims 24, 25, 27 and 30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 24 and 25 recite the limitation "contact surface". There is insufficient antecedent basis for this limitation in the claim. The examiner suggests changing "contact" to "electrode" to correct this.

Claim Rejections - 35 U.S.C. § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 17, 19-22, 26, 30-33 and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by Ingle et al. (US 2003/0139790). Ingle et al. disclose an applicator (Figure 12D, # 84B) having an electrode surface (top of RF electrodes 86B connected to a control assembly); a cooling conduit (89) capable of enclosing a fluid of constant flow, and pre-heating elements (91) thermally coupled from within the applicator body from the distal portion of the applicator body to deliver heat energy to the coolant in the conduit and capable of providing sufficient energy to heat the coolant so that the electrode surface is at a desired temperature (p. 12, [0130-0134]).

Further to claims 30-33, Ingle et al. further disclose a temperature sensor (thermocouple) for monitoring the target surface temperature [0134].

Further to claim 35, Ingle et al. disclose a processor with memory configured to store a plurality of code modules (memory segments) and algorithms for execution of the processor essentially as claimed [0134].

Note that in claims 17 and 31 the recitation in which the heaters are clearly located between the coolant and the electrode surface or directly proximal of the electrodes would distinguish the claims over this prior art.

Claim Rejections - 35 U.S.C. § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 23-25 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingle et al. in view of Edwards et al. (6,056,744).

As to claim 23, Ingle et al. fail to disclose the heating elements are resistive heating elements. But, Edwards et al. disclose the equivalence of RF and resistive heating elements for applying heat to tissue (col. 8, lines 33-57).

As to claim 24 and 27, Ingle et al. the examiner maintains that the configuration of the heating elements and the control assembly provide the capability of reducing the temperature differential across the contact (electrode) surface to less than 2 deg. C or wherein the electrode surface is between -5 and 3 deg. C. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Ingle et al., as taught by Edwards et al., to provide resistive heating elements as an alternative to RF electrodes for pre-heating of tissue.

Claims 28 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ingle et al. in view of Dobak, et al. (5,758,505). Ingle et al. fails to disclose the coolant is R134 gas. But, Dobak et al. disclose a pre-cooling system for achieving low temperatures for cryogenic treatment which contemplate the use of R134 gas or

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coolant. Therefore, at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the device of Ingle et al., as taught by Dobak et al., to provide an alternative refrigerant for cooling the electrode in contact with tissue.

Allowable Subject Matter

Claims 1-16 are allowed.

Claim 29 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy D. Gibson whose telephone number is 571-272-4767. The examiner can normally be reached on Tu-Th, 7:30 am-4:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on 571-272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roy D. Gibson
Primary Examiner
Art Unit 3739

December 23, 2005